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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/803,291	03/09/2001	Shimon Shmueli	4989-007	1208

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EXAMINER

VU, KIEU D

ART UNIT PAPER NUMBER

2173

DATE MAILED: 06/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/803,291

Applicant(s)

SHMUELI ET AL.

Examiner

Kieu D Vu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7,9,11-23,25,27-35,37 and 39-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7,9,11-23,25,27-35,37, and 39-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This Final Office Action is in response to the Amendment filed on 03/22/05.

#### ***Claim Objections***

2. Claim 41 is objected since it contains a typographical error. It appears that the phrase "executes automatically" (line 2 of the claim) is redundant and should be deleted.

#### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 5-7, 9, 11-15, 17, 21-23, 25, 27-29, 33-35, 37, and 39-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paul (USP 5,954,808) and Hendrick (USP 6792464 B2).

Regarding claims 1, 17, and 29, Paul teaches a portable device (configuration card 18) which has a body (see Figure 4B for the body of the configuration card 18), a memory (memory 20) containing software for loading into read/write memory of a host computing device (audiovideo device 10 in Figure 2) and executing on the host computing device (see col. 4, lines 14-40), said software comprising a computer program (computer instruction, col. 4, lines 15-18); an interface to facilitate interaction with the host computing device (communications Interface 22; see col. 3, lines 58-65); and the software adapted to automatically execute on the host computing device in

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association with a computing session (booting up a processor 24; col. 4, lines 46-50) and provide an interface frame associated with the portable device on a display of the host computing device (col 3, lines 58-65), and further adapted to, in association with termination of the computing session (removing the configuration card), instruct the host computing device to remove records pertaining to the computing session from the host computing device to enhance privacy associated with the computing session (reset the disk and memory catches to erase usage history; col. 5, lines 59-67). Paul differs from the claim in that Paul does not teaches that the software is further adapted to instruct the host computing device to display predefined content in relation to content displayed by a web browser such that the predefined content overlays information provided by the web browser and the predefined content displayed in a banner format. However, such feature is known in the art as taught by Hendrick. Hendrick teaches a system that allows user to connect to automatically connect to a network service provider by using a smart card (col 1, lines 13-18). Hendrick further teaches instructing the host computing device to display predefined content in relation to content displayed by a web browser such that the predefined content overlays information provided by the web browser and the predefined content displayed in a banner format (col 10, lines 1-9). It would have been obvious to one of ordinary skill in the art, having the teaching of Paul and Hendrick before him at the time the invention was made, to modify the configuration system card taught by Paul to include displaying a banner having predefined content in relation to content displayed by a web browser taught by Hendrick with the motivation being to provide user with advertisement information that is specifically directed to user profile (Hendrick, col 10, lines 6-8).

Regarding claims 5-6, 21-22, and 33-34, Paul teaches the providing a link to a web site (user's view to web pages) on the interface frame (col 5, lines 59-63).

Regarding claims 7, 23, and 35, Paul teaches the display the web content in the interface frame (user's view to web pages) (col 5, lines 59-63).

Regarding claims 9, 25, and 37, Hendrick teaches that the banner includes markup language content defined by web content (col 10, lines 1-8).

Regarding claims 12, 28, and 40, Paul teaches the pushing web content (web pages) (col 5, lines 59-63).

Regarding claims 13-14, Paul teaches the emulating and adapting as a file system (col 3, lines 28-35).

Regarding claim 15, Paul teaches the interfacing a port in the host computing device (col 1, lines 40-45).

Regarding claims 11, 27, and 39, Paul does not teach providing an authentication routine to execute on the host computing device. However, such feature is known in the art as taught by Hendrick. Hendrick's system comprises an authentication routine which verifies user's login identification and password by comparing user's login information with authentication information stored in the memory of the data card (col 4, lines 38-52). It would have been obvious to one of ordinary skill in the art, having the teaching of Paul and Hendrick before him at the time the invention was made, to modify the configuration card taught by Paul to include PIN verification taught by Hendrick with the motivation being to prevent the fraudulent use of the configuration card.

Regarding claim 41, Paul does not teach the software adapted to automatically execute on the host computing device independent of a boot state of the host computing device. However, such feature is known in the art as taught by Hendrick. Hendrick teaches a system for automatic connection to a network, the system enables software contained in a smart card to automatically execute on the system independent of a boot state of the host computing device (col 6, lines 18-26) ("upon system", "the system moves to the trigger detection step..." shows that the host computing device is booted). It would have been obvious to one of ordinary skill in the art, having the teaching of Paul and Hendrick before him at the time the invention was made, to modify Paul's system to include the feature that the software can automatically execute on the host computing device independent of a boot state of the host computing device taught by Hendrick with the motivation being to enable the software to execute without having to reboot the computer.

5. Claims 2-4, 18-20, and 30-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paul, Hendrick, and Suga et al ("Suga", USP 5497455).

Regarding claims 2, 18, and 30, Paul does not teach the displaying icon on the interface frame. However, such feature is known in the art as taught by Suga. Suga teaches a portable computer which has a task selection menu which comprises the displaying an icon, which when selected, the software will execute the corresponding function on the host computing device (col 2, lines 26-31). It would have been obvious to one of ordinary skill in the art, having the teaching of Paul and Suga before him at the time the invention was made, to modify the portable device taught by Paul to include the

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icon display taught by Suga with the motivation being to help user to easily and quickly access functions (Suga, icon screen for task selection, col 2, lines 3-5).

Regarding claims 3-4, 19-20, and 31-32, Suga teaches the display a menu icons corresponding to a menu of function icons (Fig. 4).

6. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Paul, Hendrick, and Yee et al ("Yee", USP 5781723).

Regarding claim 16, Paul does not teach a wireless interface. However, such feature is known in the art as taught by Yee. Yee teaches a system for self-identifying a portable information device which comprises the wireless interface (col 4, lines 1-3). It would have been obvious to one of ordinary skill in the art, having the teaching of Paul and Yee before him at the time the invention was made, to modify the portable device taught by Paul to include the wireless interface taught by Yee with the motivation being to enhance the portability of the system by enabling wireless communication between devices (Yee, wireless communication link, col 4, lines 32-37).

7. Applicant's arguments filed 03/22/05 have been considered but are not persuasive.

In response to Applicant's argument that since banner are normally displayed within the browser, the prior art fails to teach banner overlays the information provided by the browser, Examiner finds such argument non-persuasive because of at least two reasons. First of all, the notion that advertising banner does not overlay the information provided by the browser is simply unfounded. The whole idea of banner advertisement is for people to see the advertisement in banner. In order to "see" the banner, the

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banner has to be on top of whatever information provided by the browser, i.e. it has to overlay other displayed things. If the advertising banner is underneath and hidden away from other things the ads banner would be inoperable and does not serve its advertising purpose. Any one skilled in the art would definitely recognize this apparent "overlay" feature of the banner. Secondly, the idea that advertisement banner is somehow squeezed within other displayed info in the browser in Hendrick is unsupported by the specification is not technically desirable.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

persuasive.



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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kieu D. Vu. The examiner can normally be reached on Mon - Thu from 7:00AM to 3:00PM at 571-272-4057.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca, can be reached at 571-272-4048.

The fax phone numbers for the organization where this application or proceeding is assigned are as follows:


703-872-9306

and / or:

571-273-4057 (use this FAX #, only after approval by Examiner, for "INFORMAL" or "DRAFT" communication. Examiners may request that a formal paper / amendment be faxed directly to them on occasions).

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kieu D. Vu



**RAYMOND J. BAYERL**  
**PRIMARY EXAMINER**  
**ART UNIT 2173**